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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 565

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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There is no need or occasion for a review of the decision of the Court of Customs and Patent Appeals, reported at 397 F.2d 342. There is no conflict with other decisions, no question of general or public importance, no question of the judicial power of that Court, and no error.

The single matter that is questioned is the refusal of that Court, in reviewing a decision of the Patent Office adverse to petitioner on an issue of priority of invention, to consider also the separate question of whether or not respondent's application for patent dis-

closes the subject of the claim which was count 4 of the interference (priority) proceeding. It is asserted, on an untenable basis that was rejected below, that respondent has admitted that his application lacks that requisite disclosure. If the lack did exist, the claim of course would be invalid for lack of compliance with Section 112 of Title 35, U.S. Code. Petitioner's contention is that, because of the public interest involved in the validity of patents, the Court below should have looked into the question of respondent's disclosure, despite the fact that petitioner had failed to raise the question by the established procedure of a motion to dissolve the interference at the outset. (Patent Office Rules 231, 232 and 258).[1] Petitioner seems to assert also, but it is not the fact, that the Court's refusal was because it thought it lacked power to act.

The Primary Examiner had made the necessary threshold determination that respondent had a disclosure of the subject of count 4, because he permitted respondent to make the claim (copied from petitioner's issued patent) and he instituted the interference proceeding in order to settle the priority question, i.e., the question whether petitioner or respondent was the first inventor of that subject claimed by both. If respondent's application for patent does not disclose that subject, there would have been no need or basis for the interference proceeding. *Alpert* v. *Slatin*, 305 F. 2d 891, at 893, N. 3 (CCPA, 1962): *Brenner* v. *Manson*, 383 U.S. 519, at 528, footnote 12.

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[1] These and other Patent Office rules, as they were at the time of this interference proceeding, appear in the Appendix to this brief, together with relevant sections of Title 35 of the United States Code (Patent Act of 1952).

By such a "motion to dissolve" the interference proceeding, petitioner had questioned at the outset respondent's right to make another claim, which was count 3, but had not questioned petitioner's right to make the count 4 claim. Petitioner first sought to raise a question as to count 4 before the Board of Patent Interferences at final hearing, after testimony had been taken on the priority question. But, as the Court below said, "The Board, pointing out that no motion to dissolve as to Count 4 was made during the motion period, ruled that the question was not before it and declined to rule on it". Petitioner's Appendix, at pages 2a-3a. That was a direct application of Rule 258 of the Patent Office.

The Court also said: "We think it plain that the action of the Board with respect to claim 4 should not be disturbed because the issue was not raised by appropriate motion" (*id.*, p. 3a); and also (*id.*, p. 4a) "While Fredkin expresses the fear that Irasek will obtain a patent with an invalid claim, that question is not a matter that can be considered here", citing *Kleinman* v. *Steinbach*, 187 F. 2d 743 (CCPA, 1951) in which, on the parallel matter of a party's attempt in the Court of Customs and Patent Appeals to attack the patentability of the "count" to an opponent, the Court had said: "This is a matter for *ex parte* consideration in the Patent Office after the case is remanded to its jurisdiction" (*id.*, p. 748).

The Court of Customs and Patent Appeals has held in other cases that it has power to consider such a question of disclosure *sua sponte*, but apparently it saw no reason to take that exceptional action here. Such action is taken only when "it is clear", and when "there can be no doubt", that the party's disclosure is wanting.

Franklin v. *Hopper*, 312 F. 2d 949, at 953-4 (CCPA, 1963); *Anderson* v. *Walch*, 152 F. 2d 975, 980 (CCPA, 1946).[2]

The question about respondent's disclosure is a question of technical fact that touches the scope and the meaning of that part of count 4 which, in a certain apparatus context in the art of computers, specifies that a certain "coupling means" is "magnetic". That hinges in turn on the question whether or not respondent's disclosed electromagnetic means constitutes a magnetic coupling means in the sense of those terms in that context. Such a question inherently requires technical expertise in the art. A reviewing tribunal could not well consider it as an original question without the benefit of prior discussion and decision by the Primary Examiner, who is the one versed in the particular art and the one charged primarily with the determination of such questions both in the regular course of *ex parte* prosecution of patent applications and in *inter partes* matters on a motion to dissolve an interference proceeding.

In these circumstances, a number of reasons exist for denial of the petition.

1.

No patent containing the count 4 claim has been issued to respondent, and the decision below neither

[2] The rules of the Patent Office have a similar "fail safe" provision for the exceptional case of clear error. Thus, although under Rule 258 the Board cannot consider a question of disclosure unless the question had been raised by motion to dissolve, Rule 259 gives the Board a saving freedom to make a "recommendation" to the Commissioner of Patents, which can put the question back to the Primary Examiner.

directs nor assures nor endorses the grant of such a patent to respondent. It forecloses only the limited issue of priority of invention. See 35 U.S.C. § 144. All else, including the sufficiency of respondent's disclosure, is still open to reconsideration by the Examiner in the further *ex parte* prosecution of respondent's still pending application for patent, and in regular course it will be reconsidered after remand. See Patent Office Rule 266; and cf. *Kleinman* v. *Steinbach,* 187 F. 2d 743, at 748, 2d col. (CCPA, 1951); *in re Ruschig,* 379 F. 2d 990, at 993 (CCPA, 1967). That gives assurance of protection of the public interest by the best qualified branch of the administrative agency, the branch charged primarily with the determination of such a question. By citing *Kleinman* v. *Steinbach,* the Court below plainly showed that it contemplated such a consideration of the question in the further *ex parte* proceedings on respondent's application for patent. Petitioner's contention on the disclosure question will be available to the Examiner from the interference record, which petitioner can bring to his attention by "protest" under Patent Office Rule 291.

2.

The consideration of public interest which underlies this Court's admonition[3] that patent validity be determined in actions for infringement of patents already granted does not come to bear in a case such as this where the question touches a claim in a still pending patent application and the question therefore is still open in the Patent Office where the public interest will be protected. The refusal of the Court below to look

[3] *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U.S. 327, at 330 (1945).

into the question of respondent's disclosure was not a "last chance" to protect the public interest, and does not present a question of general or public importance warranting review by this Court.

3.

There is good reason for the disposition below and for the long established practice to which it adhered. An interference proceeding to determine a priority issue presupposes that each of the interfering parties has disclosed the subject matter of the count, just as it presupposes that that subject is a patentable novelty. 35 U.S. Code § 144; and footnote 12, at page 528, in *Brenner* v. *Manson*, 383 U.S. 519. These matters have to be determined by the Primary Examiner as threshold matters which establish that a determination of priority by the Board of Patent Interferences is needed in order to enable the Patent Office to grant the patent to the right party, the *first* inventor. Hence the established procedure requiring a motion to dissolve the interference proceeding at the outset, as a way of provoking a reconsideration of the Examiner's initial determination of these prerequisites and thereby of testing whether or not that need exists.

A sanction is needed to cause a party to raise at the outset the question of disclosure (and also the question of patentability) by that motion procedure before the Primary Examiner. The need exists in order both (a) to have the benefit of his special knowledge of the art, and (b) to avoid the great waste of time and effort that would occur in taking testimony and determining priority if the presupposed need for such a determination does not in fact exist. That needed sanction is provided by Rule 258 of the Patent Office, and by the concordant practice of the Court of Customs and Patent

Appeals which, save for the exceptional case of clear error, forbids a belated *inter partes* consideration of these threshold questions at the behest of a party who failed to present them at the proper time by a motion to dissolve. Yet if petitioner's contention were to prevail, there would be no sanction. One could wait until the evidence on priority is in and then, as here, upon seeing defeat on the priority issue, seek to oust the whole proceeding by belatedly questioning its pre-supposed and pre-determined basis. The practice adhered to below prevents that, and is necessary to an orderly administrative procedure for *inter partes* determination of issues of priority; but, as already shown, it does not foreclose the question of disclosure in the further *ex parte* proceedings.

4.

Petitioner is without basis for its assertions by which it seeks to make it seem that respondent's disclosure is clearly insufficient and that the Court's refusal to look into it therefore was in disregard of the public interest.

There has been neither an admission by respondent nor a finding by the Court that respondent did not disclose that subject. The matter stands here on the Examiner's determination that respondent did disclose it, and on respondent's consistently maintained position that he disclosed it. The Court below looked into petitioner's assertion of a contrary admission in the testimony of respondent Irasek, and found that the assertion was not supported. Petitioner misinterprets the testimony. (P. App., at pp. 3a-4a).

Further, the Court below did not find that petitioner's failure to raise the question by a timely motion to dis-

solve was the result of a "misunderstanding", on petitioner's part, of respondent's disclosure. The Court did note petitioner's assertion of a misunderstanding. The assertion, however, involves the notion that petitioner was enlightened as to respondent's disclosure by the same testimony which petitioner presented as an admission that he had not disclosed a "magnetic coupling". That is the testimony which the Court perceived was not correctly interpreted by petitioner. In effect, the Court found that the assertion of a misunderstanding has no basis.

5.

There is no basis in the opinion below for the assertion that the Court's refusal to rule on the question of respondent's disclosure was based on a refusal to recognize that it exercises judicial power when reviewing a decision of a Patent Office tribunal. See page 3, *supra*.

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